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HEWLETT-PACKARD COMPANY  
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EXAMINER

KALINOWSKI, ALEXANDER G

ART UNIT PAPER NUMBER

3626

DATE MAILED: 12/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/802,345

Applicant(s)

ALTEN, THOMAS W. VON

Examiner

Alexander Kalinowski

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 09 March 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. Claims 1-26 are presented for examination.

#### ***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims are rejected under 35 U.S.C. 101 because

Claims 19-26 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

In the present case, the instant claims fail to recite the use of any type of technology (e.g. computer system) within the recited steps of the claimed method of using a personal medical database device. The recited steps constitute an idea on how to carry and present the database device to a medical practitioner.

Mere intended or nominal use of a component, albeit within the technological arts, does not confer statutory subject matter to an otherwise abstract idea if the component does not apply, involve, use, or advance the underlying process.

Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. In the present case the claimed method recites steps for carrying and presenting a personal medical database device.

Although the claimed invention produces a useful, concrete and tangible result, since the claimed invention as a whole is not within the technological arts, as explained above, claims 19-26 are deemed to be directed to non statutory subject matter.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-26 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. With respect to independent claims 1, 10 and 19, the claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The claims are directed to a memory device having a storage density of at least 200 kb/mm<sup>3</sup>. The specification fails

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to explain how the memory device is manufactured in order to obtain the claimed storage density. The specification further fails to disclose how the claimed storage density of 200 kb/mm<sup>3</sup> was determined or arrived at. Therefore, the Examiner will not address this limitation.

Claims 2-9, 11-18 and 20-26 are rejected on the same basis based on their dependency to claims 1, 10 and 19.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 2, 3, 11, 12, 20 and 21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims contain the acronyms ARS and MREM without a definition of the acronyms in the claims. For purposes of applying prior art, the Examiner will interpret MRAM to be magnetic random access memory and ARS to be atomic resolution storage.

### ***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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8. Claims 19, 22, and 26 are rejected under 35 U.S.C. 102(e) as being anticipated by Pat. No. 6,747,561, Reeves.

As to claim 19, Reeve discloses A method for using a personal medical database device comprising at least one memory device having a storage density of at least 200 kB/mm<sup>3</sup>, the device holding personal medical information of a user, the method comprising the steps of carrying the personal medical database device; presenting the personal medical database device to a medical/dental practitioner prior to receiving medical/dental services (col. 13, lines 18-24); permitting the practitioner to review at least a portion of the medical information stored in the personal medical database device (col. 13, lines 24-27); and receiving medical/dental services from the practitioner (col. 13, lines 46-56).

As to claim 22, Reeves discloses The method of claim 19, wherein the step of carrying the personal medical database device comprises wearing the device on the user's person (see Fig. 1 and abstract).

As to claim 26, Reeves discloses The method of claim 19, further comprising the step of storing new medical/dental information relevant to the medical/dental services received in the personal medical database device after the medical/dental services have been rendered (col. 13, lines 56-67).

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1, 2, 4-7, 10, 11, and 15-18 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pat. No. 6,747,561, Reeves in view of Pat. No. 5,557,596, Gibson et al (hereinafter Gibson).

As to claim 1, Reeves discloses A personal medical database device, comprising:  
a connector for interfacing the database device with a reading/writing device (Fig. 2);  
and  
at least one memory device contained within the database device, the memory device holding personal medical information of a user of the database device (see Fig. 1 and ),  
Reeves does not explicitly disclose  
wherein the memory device has an increased storage density.  
However, Gibson discloses wherein the memory device has a high storage density (see abstract). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the aforementioned limitation for the motivation of providing a storage device with significantly increased storage density and low cost/ storage (col. 1, lines 53-56)

As to claim 2, Reeves and Gibson disclose The database device of claim 1, wherein the memory device is an ARS device (Gibson, see abstract).

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As to claim 4, Reeves and Gibson disclose The database device of claim 1, further comprising a controller contained within the database device that communicates with the reading/writing device (Reeves, see Fig. 2).

As to claim 5, Reeves and Gibson disclose The database device of claim 1, wherein the database device is sized and configured to be worn on the user's person (Reeves, see abstract).

As to claim 6, Reeves and Gibson disclose The database device of claim 1, further comprising a water resistant housing that encapsulates the memory device (Reeves, col. 7, lines 45-48).

As to claim 7, Reeves discloses The database device of claim 1, wherein the database device is no larger than approximately 1.75 x 1.5 x 0.125 inches in size (i.e. flash card).

As to claims 10, Reeves discloses A method for creating a personal medical database for a user, comprising the steps of:  
collecting medical information relevant to the user ;  
converting the medical information into electronic form (col. 13, lines 7-15); and  
writing the medical information to a portable personal medical database device (col. 13, lines 17-24)

Reeves does not explicitly disclose

having at least one memory device having high storage density.

However, Gibson discloses wherein the memory device has a high storage density (see abstract). It would have been obvious to one of ordinary skill in the art at the time of



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Applicant's invention to include the aforementioned limitation as disclosed by Gibson within Reeves for the motivation of providing a storage device with significantly increased storage density and low cost/ storage (col. 1, lines 53-56)

As to claim 11, Reeves and Gibson disclose The method of claim 10, wherein the memory device is an ARS device (Gibson, see abstract).

As to claim 15, Reeves and Gibson disclose The method of claim 10, wherein the step of transferring the medical information into electronic form comprises transferring medical history information of the user into electronic form (Reeves, col. 12, lines 25-65).

As to claim 16, Reeves and Gibson disclose The method of claim 10, wherein the step of transferring the medical information into electronic form comprises transferring current medical information of the user into electronic form (Reeves, col. 13, lines 62-67).

As to claim 17, Reeves and Gibson disclose The method of claim 10, wherein the step of transferring the medical information into electronic form comprises transferring textual information relevant to the user into electronic form (Reeves, col. 12, lines 25-65).

As to claim 18, Reeves and Gibson disclose The method of claim 10, wherein the step of transferring the medical information into electronic form comprises transferring pictorial information relevant to the user into electronic form (Reeves, col. 12, lines 17-27).

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As to claim 20, Reeves and Gibson disclose The method of claim 19, wherein the memory device is an ARS device (Gibson, see abstract).

11. Claims 3 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reeves and Gibson as applied to claims 1 and 10 above, and further in view of Shankland, Stephen, "HP flaunts new tech to raise lab profile) (hereinafter Shankland).

As to claims 3 and 12, Reeves and Gibson disclose The database device of claims 1 and 10.

Reeves and Gibson do not explicitly disclose wherein the memory device is an MRAM device.

However, Shankland discloses wherein the memory device is an MRAM device (page 2). ). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the aforementioned limitation as disclosed by Shankland within Reeves and Gibson for the motivation of using memory that retains information even when power is turned off (page 2).

12. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Reeves as applied to claim 19 above, and further in view of Shankland.

As to claim 21, the claim is substantially similar to claims 3 and 12 and is rejected on the same basis.

13. Claims 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reeves and Gibson as applied to claim 10 above, and further in view of Applicant's admission of the prior art.

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As to claim 13, Reeves and Gibson do not explicitly disclose The method of claim 10, wherein the step of transferring the medical information into electronic form comprises entering the information into a standardized database template.

However, Applicant admits that the step of transferring the medical information into electronic form comprises entering the information into a standardized database template was well known in the prior art (see specification, page 17, lines 2-16). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the aforementioned limitation within the Reeves and Gibson combination for the motivation of utilizing readily available off the shelf components in the system to reduce the overall cost of the system.

As to claim 14, Reeves and Gibson do not explicitly disclose The method of claim 10, wherein the step of transferring the medical information into electronic form comprises electronically scanning the information.

However, Applicant admits that the step of transferring the medical information into electronic form comprises electronically scanning the information was well known in the prior art (see specification, page 17, lines 2-16). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the aforementioned limitation within the Reeves and Gibson combination for the motivation of utilizing readily available off the shelf components in the system to reduce the overall cost of the system.

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14. Claims 23-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reeves as applied to claim 19 above, and further in view of Examiner's use of Official notice.

As to claim 23, Reeves discloses The method of claim 19

Reeves does not explicitly disclose wherein the step of permitting the practitioner to review at least a portion of the medical information comprises the user entering a password/passcode that facilitates access.

However, the Examiner takes official notice that it was well known in the electronic medical records art to provide users with passwords in order to access the medical records in question. The motivation was to provide access to medical records information to those parties authorized by the patient. ). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the aforementioned limitation within Reeves for the motivation stated above.

As to claim 24, Reeves discloses The method of claim 19, wherein the step of permitting the practitioner to review at least a portion of the medical information comprises the practitioner entering a password/passcode that facilitates access.

However, the Examiner takes official notice that it was well known in the electronic medical records art to provide users with passwords in order to access the medical records in question. The motivation was to provide access to medical records information to those parties authorized by the patient. It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the aforementioned limitation within Reeves for the motivation stated above.

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As to claim 25, Reeves discloses The method of claim 24.

Reeves does not explicitly disclose wherein the level of access attained by the practitioner depends upon the password/passcode entered by the practitioner.

However, the Examiner takes official notice that it was well known in the electronic medical records art to provide users with passwords that indicated the selected levels of access to the medical record in order to access the specific medical records in question. The motivation was to provide access only to specified portions of medical records information by those parties authorized by the patient. It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the aforementioned limitation within Reeves for the motivation stated above.

15. Claims 8-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reeves and Gibson as applied to claim 1 above, and further in view of Anonymous, "Storage capacity set to make quantum leap" (hereinafter Hewlett-Packard).

As to claim 8, Reeves and Gibson disclose The database device of claim 1  
Reeves and Gibson do not explicitly disclose

wherein the database device has a storage capacity of at least 1 GB.

However, Hewlett-Packard discloses wherein the database device has a storage capacity of at least 1 GB (bottom of page 1 and abstract). . It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the aforementioned limitation as disclosed by Hewlett Packard within Reeves and Gibson

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for the motivation of providing more storage on a tiny compact flash card than available on hard drives of most PC's (see pages 1-2)

As to claim 9, Reeves and Gibson disclose The database device of claim 1. Reeves and Gibson do not explicitly disclose wherein the database device has a storage capacity of at least 5 GB.

However, Hewlett-Packard discloses wherein the database device has a storage capacity of at least 5 GB (bottom of page 1 and abstract). . It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the aforementioned limitation as disclosed by Hewlett Packard within Reeves and Gibson for the motivation of providing more storage on a tiny compact flash card than available on hard drives of most PC's (see pages 1-2).

### ***Conclusion***

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. Pat. No. 5,995,077 discloses a portable wearable read/write device.
- b. Pat. No. 5,329,480 discloses nonvolatile random access memory.
- c. Pat. No. 6,545,891 discloses a modular memory device.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alexander Kalinowski, whose telephone number is (703) 305-2398. The examiner can normally be reached on Monday to Thursday from 9:00 AM to 6:30 PM. In addition, the examiner can be reached on alternate Fridays.

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If any attempt to reach the examiner by telephone is unsuccessful, the examiner's supervisor, Joseph Thomas, can be reached on (703) 305-9588. The fax telephone number for this group is (703) 305-7687 (for official communications including After Final communications labeled "Box AF").

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7th Floor, receptionist.

A handwritten signature in black ink, appearing to read "Alexander Kalinowski". The signature is fluid and cursive, with a large, sweeping initial "A".

Alexander Kalinowski

Primary Examiner

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12/9/04